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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,132	02/28/2005	Terrence E Hogan	P02039US2A	2691

7590 03/17/2009  
John M Vasuta  
Chief IP Counsel  
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EXAMINER
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RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,132	<b>Applicant(s)</b> HOGAN ET AL.	
	<b>Examiner</b> Roberto Rábago	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,8,12,14 and 16-21 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9,10,13 and 15 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/4/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapuschinski et al. (US 5,374,364).

The reference discloses at col. 3, lines 1-54, polymer terminated with thiazoline, wherein the polymer may be of isoprene, styrene-butadiene, styrene-isoprene, or ethylene-propylene-diene terpolymer. Example 1 discloses EPDM capped with thiazoline, wherein EPDM is seen to be within the scope of "polybutadiene" because the claim does not exclude ethylene and propylene comonomers. Regarding claim 5, the reference indicates that the group X<sub>1</sub> may be ketone, aldehyde or ester, and therefore meets the claim because no specific structure other than one of the named functional groups is required. Regarding claim 6, although unreported, the claimed T<sub>g</sub> would be expected to be inherent in the rubber of reference Example 1 because applicants' claimed scope is conventional for the types of rubber recommended in the reference. The burden is shifted to applicants to show otherwise.

### ***Double Patenting***

2. Claims 1, 4 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 13-31 each individually of copending Application No. 11/900,686 and Patent 7,462,677 for the reason set forth in item 5 of the Office action mailed 2/25/2008.

3. Claims 1, 4 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16, 18 and 22 of copending Application No. 11/331,663 for the reason set forth in item 6 of the Office action mailed 2/25/2008.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 3, 4, 6, 9, 10, 13 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-68 of Patent 7,186,845 for the reason set forth in item 7 of the Office action mailed 2/25/2008.

Applicant's arguments filed 12/8/2008 have been fully considered but they are not persuasive. Applicants argue that the instant claims are distinguished over the reference claims because the functional group  $\alpha$  "is at the terminal end of the polymer." However, the claims include no such requirement. There is nothing in the claims which indicates any particular bonding location of the  $\alpha$  group along the polymer chain, and therefore applicants' argument is not accepted.

5. Claims 2, 8, 12, 14 and 16-21 are allowed. Claims 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

Art Unit: 1796

independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/  
Primary Examiner  
Art Unit 1796

RR  
March 14, 2009